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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/862,948 | 05/22/2001 | David H. Levy | 13159-002001 | 9745 |
| 26161 | 7590 | 05/06/2005 | EXAMINER | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | SINGH, RAMNANDAN P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2644 | |

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,948

Applicant(s)

LEVY, DAVID H.

Examiner

Ramnandan Singh

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-90 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I: Claims 1-15, 19-20, 30-33, 44-54, 85-90, drawn to a compact keypad system and method, classified in class 379, subclass 368, as shown in Figs. 23, 35, 36, 40.

Group II: Claims 16-18, 21-29, 34-39, 40-43, 55-84, drawn to compact keypad structure, classified in class 341, subclass 22, as shown in Figs. 1-22.

2. The inventions are distinct, each from the other because Group I is drawn to a telephone keypad; and Group II is directed to a generic compact keypad structure.

3. Inventions claimed in Groups I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Groups I and II are distinct inventions. The subcombination has separate utility as shown above.

4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed invention from Groups I and II for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there is no generic claim.

5. Species in a Group:

Species of Group I:

Species I: Claims 30-33 are directed to independent key regions and
combination key regions, as shown in Fig. 40.

Species II: Claims 44-54 are directed to translating alpha key inputs into
numeric outputs, as shown in Fig. 36.

Species III: Claims 85-90 are directed to interpreting key inputs, as shown in
Fig. 35.

Species of Group II:

Species IV: Claims 21-29 are directed to tactile features, classified in class
341, subclass 27.

Species V: Claims 16-18, 40-43 are directed to a cover of a keypad, classified
in class 341, subclass 22.

6. Species I, II and III of Group- I are related as subcombinations disclosed as usable together in a single combination. Similarly, species IV and V of Group II are also related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Species I relates to a keypad having an exposed, continuous surface defining both independent key regions and combination key regions wherein a grid of sense elements underlying the surface of the keypad and responsive to motion of a human finger across the surface of the keypad; Species II deals with a keypad defining alpha key regions corresponding to individual letters for translating alpha key inputs into numeric outputs; Species III deals with a method of interpreting keypad input by sensing keypad input corresponding to a combined actuation of a plurality of independent key regions of the keypad; Species IV relates to a touch-sensitive input device wherein the exposed surface varies in elevation across its planar area to form a series of tactile features.; and Species V deals with a cover of a keypad having an exposed, continuous surface defining key regions. Since these species are separately usable, the subcombinations are distinct from each other. See MPEP § 806.05(d).

7. Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from Species I, II and III of Group I for prosecution on the merits to which the claims shall be restricted if Group I is chosen or to elect a single disclosed species from

species IV and V of Group II for prosecution on the merits to which the claims shall be restricted if Group II is chosen.

8. Applicant is advised that a reply to this requirement must include both (i) an identification of a group that is elected, and (ii) an identification of species from that group that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (571) 272-7529. The examiner can normally be reached on M-TH (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Sinh can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh
Examiner
Art Unit 2644



SINH TRAN
SUPERVISORY PATENT EXAMINER